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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,862	03/23/2004	Paulette N. Hazin	STC-01-0006	2486
30691	7590	09/11/2006	EXAMINER	
SABIC AMERICAS, INC. 1600 INDUSTRIAL BLVD. SUGAR LAND, TX 77478			NGUYEN, CAM N	
			ART UNIT	PAPER NUMBER
			1754	
DATE MAILED: 09/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,862

Applicant(s)

HAZIN ET AL.

Examiner

Cam N. Nguyen

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 19, 2006 (an election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 is/are pending in the application.
- 4a) Of the above claim(s) 23-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Election/Restriction

1. Applicant's election with traverse of Group I, claims 1-22, in the reply filed on June 19, 2006 is acknowledged. The traversal is on the ground(s) that "the Examiner has not shown the claims of Group I, Group II, and Group III to be distinct with the definition of the term "distinct" set forth in the MPEP..." and other arguments made in the response have also been noted. This is not found persuasive because of the same reasons as set forth in the last office action. Again, the three Groups of invention are not depending upon each other for completeness. The process of making of Group II and the process of using of Group III can be accomplished without the catalyst material of Group I. If all three groups searched, an additional burden is imposed to the Office due to three different search areas being required. However, in accordance with the MPEP rule, once the product claims are found allowable, the nonelected process claims will be rejoined.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 23-89 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 19, 2006.

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Claim Objections

3. Claims 1 & 22 are objected to because of the following informalities:
 - A. In claim 1, line 2, “of the formula” is suggested changed to –having a formula--.
 - B. In claim 22, line 2, “is formed into” is suggested changed to –in the form of--.

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 & 13-15 of U.S. Patent No. 6,919,472 B2 (hereinafter Pat. ‘472). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The difference between the claimed catalyst composition and that disclosed in the Pat.

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'472, is that the disclosed catalyst does not contain antimony "Sb" in the chemical formula. It would have been *prima facie* obvious to one of ordinary skill in the art at the invention was made to have added the "Sb" to the catalyst composition of the Pat. '472 in order to achieve an improved catalyst activities such as having multi-functions and capabilities, etc. because "Sb" is a known catalytic material (see art cited on PTO-892 Form attached).

6. Claims 1-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 7,009,075 B2 (hereinafter Pat. '075). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The claimed catalyst composition and the disclosed catalyst composition appear to be the same. It would have been *prima facie obvious* to one of ordinary skill the art at the time the invention was made to have used the claimed catalyst composition for the same process because the same catalyst material is inherently suitable for the same process.

Claim Rejections - 35 USC § 102(e)

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Karim et al., "hereinafter Karim", (US Pat. 6,620,973 B2).

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Karim discloses a catalyst containing a catalyst composition having the formula:

$\text{Mo}_a\text{Pd}_b\text{Bi}_c\text{Fe}_d\text{X}^1_e\text{X}^2_f\text{X}^3_g\text{O}_z$ wherein: X^1 is at least one element selected from the group consisting of Co, Ni, V, Pt, and Rh; X^2 is at least one element selected from the group consisting of Al, Ga, Mn, Nb, Zn, Ag, P, Si and W; X^3 is at least one selected from the group consisting of K, Mg, Rb, Ca, Sr, Ba, Na, and In; etc. (see col. 6, claim 8). The catalyst further comprising a support (see col. 6, claims 9-10).

There is no patentable distinction seen between the claimed catalyst composition and that disclosed by the reference. Thus, the claims are anticipated by the teaching of Karim.

Claim Rejections - 35 USC § 102(a)

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 1-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Chaturvedi et al., “hereinafter Chaturvedi”, (US Pat. 6,504,053 B1).

Chaturvedi discloses a catalyst containing a promoted mixed metal oxide having the empirical formula $\text{A}_a\text{M}_b\text{N}_c\text{X}_d\text{Z}_e\text{O}_f$ wherein A is at least one element selected from the group consisting of Mo and W, M is at least one selected from the group consisting of V and Ce, N is at least one element selected from the group consisting of Te, Sb, and Se, X is at least one selected from the group consisting of elements including Nb and other claimed elements, and Z is selected from the group consisting of Ni, Pd, Cu, Ag, and Au; etc. (see col. 26, claim 1). The

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metal components of the catalyst may be supported on support materials such as alumina, silica, silica-alumina, zirconia, titania, etc. (see col. 10, ln 33-36).

There is no patentable distinction seen between the claimed catalyst composition and that disclosed by the reference. Thus, the claims are anticipated by the teaching of Chaturvedi.

Claim Rejections - 35 USC § 102(b)

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ushikubo et al., “hereinafter Ushikubo”, (US Pat. 5,472,925).

Ushikubo discloses a catalyst having the empirical formula: $\text{Mo}_a\text{V}_b\text{Te}_c\text{X}_x\text{O}_n$ wherein X is at least one element selected from the group consisting of Nb, Ta, etc. including the claimed elements (see col. 29, claim 1). The catalyst can be used together with a conventional carrier such as alumina, silica, etc. (see col. 7, ln 20-24).

There is no patentable distinction seen between the claimed catalyst composition and that disclosed by the reference. Thus, the claims are anticipated by the teaching of Ushikubo.

Citations

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form attached.

Conclusion

14. Claims 1-89 are originally pending. Claims 1-22 are rejected. Claims 23-89 are withdrawn due to non-elected (distinct) invention(s). No claims are allowed.

Contacts

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Nguyen/cnn

Primary Examiner

September 02, 2006

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